

## REMARKS

This Response is submitted in response to the Office Action dated January 2, 2004.

Claims 1 to 50 are pending in the application. A Terminal Disclaimer is submitted herewith, and a check in the amount of \$110.00 is submitted herewith to cover the cost of the Terminal Disclaimer. A Petition for a Two-Month Extension of Time to Respond to the Office Action and a check in the amount of \$420 to cover the fees of the two-month extension are submitted herewith. Please charge Deposit Account No. 02-1818 for any other fees that are deemed necessary.

The Office Action objected to the disclosure for informalities contained therein. Applicants have amended the Specification to correct the informalities and have corrected other informalities without adding new subject matter to the disclosure. Applicants respectfully submit that such amendments overcome the objections to the Specification.

The Office Action rejected Claims 1 to 50 under the non-statutory, judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 6 to 9, 13 to 15, 16, 20 to 25 and 28 of co-pending Application No. 09/933,843. Applicants are hereby submitting a Terminal Disclaimer to overcome this rejection.

Claims 1 to 2, 4 to 7, 12 to 25, 30 to 32, 34 to 40, 42, and 47 to 50 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,589,114 to Rose ("*Rose*"). Applicants respectfully disagree and traverse these rejections for the reasons discussed below.

**A. *Rose* is not prior art to the presently claimed invention.**

*Rose* is not prior art to the presently claimed invention. The presently claimed invention was conceived prior to the effective date of *Rose* which is July 25, 2001. The Affidavit of Darren Maya and the attached evidence submitted therewith demonstrate that the claimed invention was conceived at least as early as February 16, 2001 and

that art work was being prepared for a commercial embodiment of the present invention at least as early as March 23, 2001. This demonstrates reduction to practice of the invention by that date. Therefore, *Rose* is not prior art to the presently claimed invention.

Moreover, the claims in the present application are directed to different inventions than the claims in *Rose*; therefore, the affidavit of Darren Maya is appropriately filed under 37 C.F.R § 1.131. For example, Claim 1 of the present invention is directed to a gaming device including a display device, a plurality of player-selectable positions displayed by the display device, and a processor which communicates with the display device. The processor enables a player to select the positions and associates numbers with the positions based on the player's order of selection of the positions. The processor then determines an award to be provided to the player. The amount of the award provided to the player is based on a number of monetary units equal to the order of the numbers associated with the positions.

*Rose* does not claim or disclose a processor which enables a player to select positions and which associates numbers with the positions based on the player's order of selection of those positions. Therefore, *Rose* does not claim the same patentable invention as the presently claimed invention as defined in 37 C.F.R. §1.601(n). Accordingly, because *Rose* is not prior art to the presently pending claims in view of the Affidavit submitted herein, the rejection should be withdrawn.

**B. *Rose* does not disclose or teach the presently claimed invention.**

Even assuming, *arguendo*, that *Rose* is prior art to the claimed invention, *Rose* does not disclose the presently claimed invention. *Rose* discloses a shuffle feature in which value-based symbols generated along an active pay line each reveal a respective number superimposed over each of the symbols. Col. 3, line 64 – Col. 4, line 4. The revealed numbers represent each of the respective digits of a credit amount that defines a first award which is not awarded to the player. Col. 4, lines 6-11. When executing the shuffle feature, the CPU in *Rose* randomly selects one of a possible number of credit amounts which include different arrangements of the revealed numbers based on a

weighted probability table. Col. 4, lines 31-33. The CPU then causes the symbols and their respective numbers to be re-ordered to show the randomly-selected credit amount that defines a second amount which is awarded to the player. Col. 4, lines 47-50 and lines 21-25. The revealed numbers remain with the respective symbols as the symbols are re-ordered such that the numbers are likewise re-ordered. Col. 4, lines 15-18 and Figures 5 to 7. This random re-ordering may occur with or without "player interaction" to define an award given to the player. Col. 5, lines 3-9.

**1. *Rose* does not disclose a processor which enables a player to select positions.**

The Office Action relies on a reference to "player interaction" in the disclosure of *Rose*. The reference states, "[t]he scene would include a sequence of value-based symbols that are randomly re-ordered, with or without player interaction, to define an award given to the player." This "player interaction" is associated with randomly re-ordering symbols, and has nothing to do with enabling a player to select positions. In *Rose*, all of the numbers in an award have been already revealed to the player before the numbers can be randomly re-ordered with player interaction, and the numbers remain with their respective symbols throughout the re-ordering. Therefore, enabling a player playing the bonus game taught by *Rose* to select positions for these revealed numbers would no longer be random and would be meaningless because the player would always pick the highest possible value.

The "player interaction" contemplated by *Rose* apparently allows the player to initiate a random re-ordering of the numbers by the CPU. For example, as illustrated in Fig. 4 of *Rose*, the player may be enabled to initiate a random shuffling of the revealed numbers, zero 60, two 62 and four 64. The player takes a chance that the revealed numbers will be shuffled to a higher number or award. However, allowing the player to position the revealed numbers so that the numbers yield the highest possible award of four hundred twenty would be meaningless because the player would always pick the highest possible value.

**2. *Rose* does not disclose a processor which associates numbers with the positions based on the player's order of selection of those positions.**

As discussed above, *Rose* discloses a CPU that randomly selects one of a number of possible credit amounts based on a probability table that is weighted to favor the smaller credit amounts over the higher credit amounts, that is weighted equally, or is weighted to favor the higher credits amounts over the lower credit amounts. Col. 4, lines 50-57. *Rose* fails to disclose associating numbers with positions based on an order the player selects for those positions.

Similarly, *Rose* fails to disclose a processor which determines the amount of an award based on an order of masked numbers arranged by a player (Claim 12), a processor which determines the amount of an award based on an order of a plurality of numbers of selections associated by a player with a plurality of positions (Claim 30) or digits (Claims 47 to 49), and a processor which determines the amount of an award based on an order of the numbers associated with the selections in a digit selected by a player by means of a selection orderer (Claim 42).

Accordingly, it is respectfully submitted that Claims 1 to 2, 4 to 7, 12 to 25, 30 to 32, 34 to 40, 42, and 47 to 50 are patentably distinguished over *Rose*, assuming *arguendo* *Rose* is prior art, and that Claims 1 to 2, 4 to 7, 12 to 25, 30 to 32, 34 to 40, 42, and 47 to 50 are in condition for allowance.

Claims 33, 43 to 46 and 50 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Rose*. This rejection should be withdrawn because Applicant has sworn behind *Rose*.

Even assuming *arguendo* *Rose* is prior art, the Office Action admits that:

(1) *Rose* fails to disclose the limitations of an award which includes a different number of selections than the plurality of selections displayed by the display device (Claim 33);

(2) *Rose* fails to disclose a selection orderer which is adapted to enable the player to rearrange an ordering of the selections a plurality of times before pressing a keep button displayed by the display device (Claim 43);

(3) *Rose* fails to disclose a selection orderer which includes a prompt to place a selection in a designated position (Claim 44);

(4) *Rose* fails to disclose a selection orderer which enables the player to press and drag a selection to a position (Claim 45); and

(5) *Rose* fails to disclose a selection orderer which remembers a selection chosen by a player and which places the selection in a position subsequently chosen by the player (Claim 46).

The Office Action rejects these features of the claimed invention as being obvious by characterizing the features as "notoriously well known computer-based applications". Furthermore, the Office Action relies on a statement in *Rose* that "those skilled in the art will recognize that many changes may be made [to the present invention] without departing from the spirit and scope of the present invention" to create a context in which to justify any expansive modification of *Rose*. See Office Action, page 13. Applicants respectfully disagree and traverse this reasoning and rejection.

The use of a general goal common to substantially all gaming machines as the motivation to modify the present invention, without more, lacks the level of specificity required to make such a modification. Obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). The mere fact that a prior art device "may be capable of being modified to run the way the apparatus is claimed," is insufficient; "there must be a suggestion or motivation in the reference to do so." *In re*

*Mills*, 916 F.2d 680, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990). Furthermore, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness. MPEP §2143.01. Therefore, it is well established that a specific motivation must be identified in the prior art to establish that there is adequate teaching or suggestion to modify the cited reference to make the present invention.

Characterizing the claimed features as computer based applications which are “notoriously well-known”, easily implemented in computer program(s) running gaming machines and which “allow[s] the gaming machine to remain profitable for a casino operator” is not only inaccurate, but also it constitutes general rather than specific reasons for any changes to *Rose* as required by the Federal Circuit to support the conclusion of obviousness. If such reasoning were an appropriate basis for finding inventions obvious, it would be virtually impossible to patent any invention in the gaming field. Thus, Applicant respectfully submits that the present Office Action does not explain how or why the skilled artisan would have been specifically motivated to modify *Rose* and requests that the rejections be withdrawn.

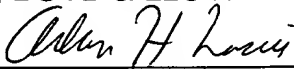
Claims 33, 43 to 46 and 50 depend from independent Claims 30, 42 and 49, respectively, which, Applicants respectfully submit are in condition for allowance based on the discussion above. Therefore, Claims 33, 43 to 46 and 50 are also in condition for allowance.

Claims 3 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Rose* in view of U.S. Patent No. 5,205,555 to Hamano. *Rose* is not prior art. Even assuming *arguendo* *Rose* is prior art, Applicants traverse this rejection based on the lack of teaching, suggestion or motivation in the art to combine these references. Further, Applicants respectfully submit that, because Claims 3 and 29 depend from independent Claims 1 and 12, respectively, which, as discussed above, are in condition for allowance, Claims 3 and 29 are also in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY 

Adam H. Masia  
Reg. No. 35,602  
P.O. Box 1135  
Chicago, Illinois 60690-1135  
Phone: (312) 807-4284

Dated: May 25, 2004